

**REMARKS**

Claims 1-35 are pending in this application. New claims 23-35 include new independent product claim 31. Favorable consideration of all claims is earnestly solicited.

The Examiner is respectfully thanked for the consideration given the present application. Applicants also note the Examiner's acknowledgement of the claim for priority to both the provisional application and Swedish Application as well as receipt of the certified copy of the priority document.

**The Section 112 Rejection**

The Examiner has rejected claims 3, 9, 13, 15, 17, 20, 21, and 22, alleging that these claims are indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In particular, the Examiner contends that the term "character" as utilized by Applicants is indefinite, alleging that the term "character" may have a broad or narrow meaning, relying on a citation to the dictionary. This rejection is respectfully traversed for the following reasons.

While Applicants are appreciative of the Examiner's concerns in the present application, it is respectfully submitted that the specification of the present application clarifies the intended meaning of the term "character" so as to avoid the ambiguity alleged by the Examiner. As used in the present application, the term "character" refers to a graphic symbol used in writing or printing such as an alphabetic or other printed character or hieroglyphic. The Examiner's equation of character to "alphabet" is unduly narrow and inconsistent with examples in the specification. See for example, page 7,

line 2 using @ as a character example and page 16, line 8 that contemplates 256 different characters, more than any alphabet generally contains. Nothing within the specification of the present application suggests that the term "character" is limited to an alphabetical character, as opposed to other types of written characters, e.g. punctuation and pictograph characters such as Japanese kanji. While the preferred embodiment set forth in the specification anticipates use of a western alphabet, it is submitted that the claims of the present application should not be so limited and thus, the Examiner's rejection should be reconsidered and withdrawn.

### **The Section 102 Rejection**

The Examiner has rejected claims 15 and 20 as being allegedly anticipated by the Dymetman patent under 35 U.S.C §102. This rejection is respectfully traversed to the extent it applies to these claims, as amended, for the following reasons.

Claim 15 is directed to a apparatus for transmitting handwritten information written on a surface having a handwritten information area and a character area. The means for converting the position-coding pattern reads position which is at least similar to the page identifier and page location used in Dymetman. The means for converting the recorded image to at least one character is not present in Dymetman. This means converts the address-coding pattern directly to at least one character which is used by the means for transmitting as an address to transmit the handwritten information.

Contrary to the assertion made by the examiner, the Dymetman does not employ a address-coding pattern. In Dymetman, the page identifier and location information are both position codes. Both of these codes define the position of the box or region of the

Dymetman code and thus represent information solely by position. The address coding pattern used in the address area is a pattern which does not identify position but which identifies one or more characters which may form part of an address.

In the preferred embodiment of the present application, the amount of displacement of a code string from one row or column to the next row or column is determined. This offset or displacement is representative of a character which is desirably part of an address. Thus, in accordance with the present invention, the address is determined by determining characters from the address coding pattern. In the Dymetman reference, any address information must be determined by determining position and using the position to determine that, or if, the position is associated with address information. This requires a remote computer to make a determination directly calculated from the address coding pattern in accordance with the teachings of the present application. Thus, it is apparent that the Dymetman patent does not use a address coding pattern as claimed and does not determine characters from this pattern that are used to transmit the handwriting to the address determined by the address coding pattern.

Claim 20 is a method claim generally corresponding to apparatus claim 15. It is respectfully submitted that this claim is also patentable for the reasons generally discussed above.

For all of the above-submitted reasons, it is respectfully submitted that claims 15 and 20 are not anticipated as asserted by the examiner. Reconsideration and withdrawal of the rejection is requested. If the examiner persists in applying this

rejection, the examiner is requested to explain what is being relied on in Dymetman to disclose the address-coding pattern and how this is converted to at least one character.

### **The Section 103 Rejection**

Independent claim 1, and the remaining claims 2-6, 10-14, 16, 17, 19, 21, and 22 were rejected by the Examiner as being unpatentable under 35 U.S.C. § 103, over Dymetman et al. (applied above) in view of the MacWilliams publication. The Examiner's rejection is respectfully traversed for the following reasons.

The Examiner in his rejection recognizes that the Dymetman reference detects position on the basis of address information defined wholly within cell borders within the writing area, and is thus not a position coding pattern<sup>1</sup> which enables unambiguous detection of position from an arbitrary position within the pattern. The Dymetman reference does not have any code pattern of a plurality of first symbols, wherein an arbitrary position area of a predetermined first size of the position coding pattern unambiguously defines a position on the surface. This type of pattern is of course not disclosed in the Dymetman reference as recognized by the Examiner in his 35 U.S.C. § 103 rejection. Consequently, Applicants will discuss the patentability of these claims in greater detail with respect to this rejection as set forth below. Thus amendment of these claims clearly overcomes the examiner's anticipation rejection.

The Examiner relies on the MacWilliams publication to allegedly teach this principle. However, for the reasons set forth below, the combination advanced by the Examiner may not be properly applied against the claims of the pending application.

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<sup>1</sup> For the reasons set forth above, it is submitter that the pattern in Dymetman may not be considered a position coding pattern and the examiners rejection is deficient for this reason.

Accordingly, the Examiner is respectfully requested to reconsider and withdraw this rejection.

As recognized by the Examiner, the Dymetman patent divides a sheet into a plurality of predefined areas, each area having a sheet identifier and a position marking contained within the code. The code in the Dymetman reference may be detected only if the entirety of the information within that zone is read. Thus, once the entirety of the zone is read, a simple direct conversion of information within the zone may be made in order to unambiguously determine position of the zone.

In contrast, in accordance with the teachings of the present application, the position coding pattern allows detection of position from any arbitrary position so long as an arbitrary position area of a predetermined first size is read. This would be roughly analogous to the unambiguous determination of position in the Dymetman reference from part of the position data from at least two adjacent zones of the Dymetman pattern, wherein the entirety of neither zone is read. Dymetman clearly fails to teach or suggest how to accomplish such a determination of position from such a pattern.

The MacWilliams patent applied by the Examiner discloses mathematical or binary sequences or arrays having "nice properties." Nowhere in this publication is any explanation of the possible utility of such arrays. The Examiner contends that:

One of ordinary skills in the art would recognize the benefit of eliminating cell borders and in addition a higher resolution by incorporating the use of pseudo-random sequence in coding pattern.

For this reason, the Examiner concludes that it would be obvious to modify Dymetman to incorporate the teachings of MacWilliams. It is respectfully submitted that the

Examiner has indulged in hindsight reconstruction of the invention from references which do not fairly suggest this combination.

As is clear from the applicable case law, the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI INT'L Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). In the present application, the Examiner is definitely relying on the alleged skill of one of ordinary skill in the art, the Examiner pointing to neither references as being the source of his alleged motivation to combine these references. This is clearly improper motivation to support the examiner's alleged combination.

Perhaps even more importantly, the proposed modification of the Dymetman reference may not be accomplished without changing the principal of operation of the reference. The determination of position based on reading an arbitrary position area of a position code requires decoding techniques described in association with the specification of the present application. Such decoding techniques do not allow a simple reading of a position code as that used in the Dymetman reference. Indeed, replacing the Dymetman code with a code such as that disclosed in the MacWilliams reference, even assuming a teaching existed to make such a combination, would prevent the structure disclosed in the Dymetman reference from determining position.

If the proposed modification or combination of the prior art would change the principal of operation of the prior art structure being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (C.C.P.A. 1959) see also the description of the basic

requirements of a *prima facie* case of obviousness as set forth in MPEP §§ 2142, 2143, and in particular, 2143.01.

As was true in the case of *Ratti*, *supra*, in the present application the Examiner's proposed modification would "require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principal under which the [primary reference] construction was designed to operate." *Ratti*, at 270 F.2d at 813, 123 USPQ at 352.

For the above reasons, it is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness as to any of the claims presently pending in the present application. Consequently, in view of the absence of such a *prima facie* case, the Examiner is requested to reconsider and withdraw the rejection as it applies to the claims as they are presently pending in the instant application.

For all of the above stated reasons, reconsideration and withdrawal of the rejections and allowance of all claims are earnestly solicited.

Applicants respectfully thank the Examiner for the indication of allowable subject matter in claims 5-9 and 18. However, for the reasons set forth above, it is not believed necessary to place claims 5-9 and 18 in independent form at the present time.

#### **New Claims**

New claims 23-35 have been added by this response. All of these claims are allowable for at least the reasons discussed above.

In the even that there are any matters which remain outstanding in the present application, the Examiner is invited to contact the undersigned at (703) 205-8000 in Northern Virginia, in order to discuss this application.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicants respectfully petition for a one (1) month extension of time for filing a reply in connection with the present application, and the required fee of \$110.00 is attached hereto.

If necessary, the Commissioner of hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Respectfully submitted,

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